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FULBRIGHT JAWORSKI

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12/3 Rec'd PCT/PTO 01 DEC 2005

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NY-DNAG-305-US (10506587)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Gros, et al.
Serial Number : 10/540,721
Filing Date : June 24, 2005
For : METHOD FOR COATING METALLIC SURFACES, COATING
COMPOSITION, AND COATINGS PRODUCED IN SAID
MANNER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
MS: PCT

November 30, 2005

LETTER SUBMITTING IPER

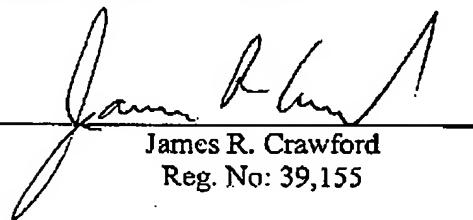
Sir:

Submitted herewith is a copy of the translation of the IPER for PCT/EP2004/000108
(PCT/IPEA/409), together with a copy of PCT/IB/338.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

By


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Enclosure

PATENT COOPERATION TREATY

PCT/EP2004/000108

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

To:

UPPENA, Franz
Dynamit Nobel Aktiengesellschaft
Patente, Marken & Lizenzen
53840 Troisdorf
ALLEMAGNE

Eng.-Dat: 1 7. NOV. 2005

Eng.-Nr.:

0059692
OZ 03001 SB: HB
ED: 17.11.2005

Date of mailing (day/month/year)
10 November 2005 (10.11.2005)

Applicant's or agent's file reference
OZ 03001 WO/HB

IMPORTANT NOTIFICATION

International application No.
PCT/EP2004/000108

International filing date (day/month/year)
09 January 2004 (09.01.2004)

Applicant

CHEMETALL GMBH et al

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

KR

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.



*P0059692*OZ 03001 SB: HB ED:
17.11.2005

The International Bureau of WIPO
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Form PCT/IB/338 (January 2004)

Translation

PATENT COOPERATION TREATY

PCT/EP2004/000108



PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference OZ 03001 WO/HB	FOR FURTHER ACTION See Form PCT/PEA/416	
International application No. PCT/EP2004/000108	International filing date (day/month/year) 09 January 2004 (09.01.2004)	Priority date (day/month/year) 11 January 2003 (11.01.2003)
International Patent Classification (IPC) or national classification and IPC C09D 5/08, 4/00		
Applicant CHEMETALL GMBH		

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☒ (sent to the applicant and to the International Bureau) a total of 13 sheets, as follows:

☒ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in Item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

- ☒ Box No. I Basis of the report
- ☐ Box No. II Priority
- ☒ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

Date of submission of the demand 29 June 2004 (29.06.2004)	Date of completion of this report 20 April 2005 (20.04.2005)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

Form PCT/PEA/409 (cover sheet) (January 2004)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. PCT/EP2004/000108
Box No. I	Basis of the report	
<p>1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.</p> <p><input type="checkbox"/> This report is based on translations from the original language into the following language _____, which is language of a translation furnished for the purpose of:</p> <p style="margin-left: 20px;"> <input type="checkbox"/> international search (under Rules 12.3 and 23.1(b)) <input type="checkbox"/> publication of the international application (under Rule 12.4) <input type="checkbox"/> international preliminary examination (under Rules 55.2 and/or 55.3) </p> <p>2. With regard to the elements of the international application, this report is based on <i>(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)</i>:</p> <p><input type="checkbox"/> The international application as originally filed/furnished</p> <p><input checked="" type="checkbox"/> the description:</p> <p style="margin-left: 20px;"> pages _____ 1-4, 7-14, 17-63 _____, as originally filed/furnished pages* _____ 1a, 5, 6, 6a, 15, 16, 16a _____ received by this Authority on _____ 22 October 2004 (22.10.2004) pages* _____ received by this Authority on _____ </p> <p><input checked="" type="checkbox"/> the claims:</p> <p style="margin-left: 20px;"> pages _____ 3-26, 27(in part), 39 (in part), 40 _____, as originally filed/furnished pages* _____, as amended (together with any statement) under Article 19 pages* _____ 1, 2, 27 (in part), 28-38, 39 (in part) _____ received by this Authority on _____ 22 October 2004 (22.10.2004) pages* _____ received by this Authority on _____ </p> <p><input type="checkbox"/> the drawings:</p> <p style="margin-left: 20px;"> pages _____, as originally filed/furnished pages* _____ received by this Authority on _____ pages* _____ received by this Authority on _____ </p> <p><input type="checkbox"/> a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.</p> <p>3. <input type="checkbox"/> The amendments have resulted in the cancellation of:</p> <p style="margin-left: 20px;"> <input type="checkbox"/> the description, pages _____ <input type="checkbox"/> the claims, Nos. _____ <input type="checkbox"/> the drawings, sheets/figs _____ <input type="checkbox"/> the sequence listing (specify): _____ <input type="checkbox"/> any table(s) related to sequence listing (specify): _____ </p> <p>4. <input type="checkbox"/> This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).</p> <p style="margin-left: 20px;"> <input type="checkbox"/> the description, pages _____ <input type="checkbox"/> the claims, Nos. _____ <input type="checkbox"/> the drawings, sheets/figs _____ <input type="checkbox"/> the sequence listing (specify): _____ <input type="checkbox"/> any table(s) related to sequence listing (specify): _____ </p>		
<p>* If item 4 applies, some or all of those sheets may be marked "superseded."</p>		

Form PCT/IPBA/409 (Box No. I) (January 2004)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/000108

Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application.

☒ claims Nos. 32-38

because:

☐ the said international application, or the said claims Nos. _____
relate to the following subject matter which does not require an international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____
are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. _____ are so inadequately supported
by the description that no meaningful opinion could be formed.

☒ no international search report has been established for said claims Nos. 32-38.

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the
Administrative Instructions in that:

the written form

☐ has not been furnished

☐ does not comply with the standard

the computer readable form

☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with
the technical requirements provided for in Annex C-bis of the Administrative Instructions.

☐ see Supplemental Box for further details.

Form PCT/PEA/409 (Box No. III) (January 2004)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY		International application No. PCT/EP2004/000108
Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	
1. Statement		
Novelty (N)	Claims 1-31, 39, 40	YES
	Claims	NO
Inventive step (IS)	Claims 1-31, 39, 40	YES
	Claims	NO
Industrial applicability (IA)	Claims 1-31, 39, 40	YES
	Claims	NO
2. Citations and explanations (Rule 70.7)		
Reference is made to the following document:		
D1: DE 199 25 631 A (GROS GEORG) 7 December 2000 (2000-12-07).		
<p>Document D1 is considered to be the prior art closest to the subject matter of claim 1. Said document discloses (the references in parentheses are to D1):</p> <p>a method for applying an anti-corrosion coating to a metallic substrate, in particular to a body sheet for use in the automotive industry, and also a coating composition (column 1, first paragraph). This coating composition is hardened by actinic radiation and contains a polymer binder, for example epoxy resins, polyurethanes or esterification products of resins of this type with acrylic or methacrylic acid and at least one polymerisable monomer, for example an ester of the acrylic or methacrylic acid, and also a photo initiator, for example benzoin ether or amino ketones (column 2, lines 5-64).</p> <p>The total content of polymers, oligomers and monomers is greater than 50 wt.%, the content of monofunctional</p>		

Form PCT/PEA/109 (Box No. V) (April 2005)

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/000108

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

monomer is generally between 20 and 60 wt.% and the content of photo initiator is between 5 and 30 wt.% (column 3, line 14-23). In addition, the composition can contain further additives, such as soluble corrosion-inhibitors and corrosion pigments (column 3, line 6-13). The layer thickness of the applied coating (whether wet or dry) is generally between 2 and 8 μm (column 3, line 51-55).

Thus, the subject matter of claim 1 differs from D1 in that the anti-corrosion composition contains an elastifying resin and an isobornyl acrylate and/or an isobornyl methacrylate.

The subject matter of claim 1 is therefore novel (PCT Article 33(2)).

The problem addressed by the present invention can consequently be regarded as that of proposing an anti-corrosion composition which contains little or no water or organic solvent, being of a particularly high quality with regard to lacquer adhesion and corrosion protection.

The solution to this problem, as proposed in the present application, involves an inventive step (PCT Article 33(3)). The reasons are as follows:

although the anti-corrosion composition described in D1 can be free of inert volatile solvents, for a person skilled in the art, D1 contains nothing to suggest

/...

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/000108

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement

the use of an elastifying resin or an isobornyl
(meth)acrylate in said composition.

Assuming that claim 2 is dependent on claim 1 (see
Box VIII below), claim 2 is also novel and inventive.

Claims 3-30 are dependent on claim 1 and, in consequence,
also satisfy the requirements of the PCT in respect of
novelty and inventive step.

This applies likewise to product claim 31, since it
has the same distinctive feature relative to D1 and to
use claims 39 and 40, which relate to special uses of
the substrates coated according to the method of claim 1.

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/000108

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

The examiner has assumed that the anti-corrosion composition referred to in claim 2 is the same as the anti-corrosion composition according to claim 1 (see page 9, lines 20-25). In consequence, claim 2 is dependent on claim 1 and should therefore refer back thereto.

Form PCT/ISA/409 (Box VIII) (April 2005)